UNITED STATES PATENT AND TRADEMARK OFFICE

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER
NGUYEN, TAN D

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _23 December 2008_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _94,100,104,108 and 109_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _94,100,104,108 and 109_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

12/23/08 has been entered.

Response to Amendment

2.   The amendment of 12/23/2008 has been entered. Claims 94, 108-109, 100, 104,

are pending and rejected as below. Claims 1-93, 101-103, and 105-107 have been

canceled. The claims comprise:

   1) server: 94, and 108-109,

   2) method: 100, and

   3) medium: 104.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

   Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
   matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
   conditions and requirements of this title.

4.   Claims 94, 108-109 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

5.   Note: that it appears that independent claim 31 is an apparatus claim. In

examination of the apparatus claim, the claims must be structurally distinguishable from

the prior art. While features of an apparatus claim may be recited either structurally or

functionally, claims directed to an apparatus must be distinguished from the prior art in

terms of structure rather than function. See MPEP 2114. *In re Schreiber, 128 F.3d*

1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover

what a device is, not what a device does. Hewlett-Packard Co. vs. Bausch & Lomb Inc.

(Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e.

recitation with respect to the manner in which a claimed apparatus is intended to be

employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte*

Masham, 2 USPQ2d 1647 (BPAI, 1987).

> ***Server***: "2. On the Internet or other network, a computer or program that responds to
>
> commands from a client." Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA,
>
> 1997.

6.   Current claims 94 and 108-109 comprise a server which can be software

components or program. There are no citations of an apparatus or structural elements

or devices such as processor or computer or computer server. Terms such as "an input

section, a database, a calculator, an exception handler, a generator, and provider are

software components or functions and have no patentable weight in an apparatus

claims.

Claim Rejections - 35 USC § 112

7.   Claims 94, 108-109 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

1) The term "a first calculator, arranged to calculate" appears to be redundant and vague since what else a function "a first calculator" does besides "to calculate"?. Similarly, the term ""a second calculator, arranged to calculate" is also redundant and indefinite.

2) The phrase "an exception handler, arranged to send an inquiry to the user regarding why the collecting rate is greater than 100%, and suspend operation" is vague because, to be consistent with the previous language, "an exception handler" should be arranged to handle exception.

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9.   The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

10.   This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

11.   Claims 94 (apparatus), 108-109, 100 (method), and 104 (computer program

product) are rejected under 35 U.S.C. 103(a) as being unpatentable over (1)

Applicant Admitted Prior Art (AAPA) in view of (2) JOHNSON et al and (3)

ROGERS et al.

As of 12/23/08, independent system claim 94 is as followed:

94. (currently amended): A server, which communicates with a plurality of client

computers through a computer network, for discriminating log-in information received

from each client computer, and transmitting data of an order screen used by a user for

the purpose of ordering a new consumable, to a logged-in client computer, said server

comprising:

a) a first input section, arranged to input order data of a new consumable

inputted by a user who uses the order screen displayed on a monitor of the logged-in

client computer;

b) a second input section, arranged to input collecting data of a used

consumable returned from the user;

c) a database which stores the order data and the collecting data in relation

with the log-in information;

d) a first calculator, arranged to calculate a collecting rate from a plurality of

the order data and a plurality of the collecting data stored in said database;

e) a second calculator, arranged to calculate incentive data based on ~~a plurality~~

~~of the order data and a plurality of the collecting data stored in said database~~ the

collecting rate in a unit of the log-in information;

f) an exception handler, arranged to send an inquiry to the user regarding why

the collecting rate is greater than 100%, and suspend operation of said second

calculator if the user does not respond or adjust the collecting rate otherwise;

g) a generator, arranged to generate price data of the new consumable in

accordance with the incentive data in the unit of the log-in information; and

h) a provider, arranged to provide the logged-in client computer with the price

data corresponding to the log-in information of that client computer to display a price of

the new consumable on the order screen, and, in response to an instruction of the user,

to provide the logged-in client computer with data of a confirmation screen to be

displayed to the user, which includes the order data, the collecting data, the collecting

rate, and the incentive data as a discount rate of a new consumable corresponding to

the log-in information of that client computer, ~~to report a collection rate of the used~~

~~consumable, and the incentive data as a discount rate of a new consumable to the user.~~

Note: independent claim 94 is (appears to be) an apparatus claim. In

examination of the apparatus claim, the claims must be structurally distinguishable from

the prior art. While features of an apparatus claim may be recited either structurally or

functionally, claims directed to an apparatus must be distinguished from the prior art in

terms of <u>structure</u> rather than function. See (1) MPEP 2114. (2) *In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997)*. Apparatus claims cover what a <u>device is</u>, not what a device does, i.e. "device which acts or performs ...". (3) *Hewlett-Packard Co. vs. Bausch & Lomb Inc. (Fed. Circ. 1990)*. Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. (4) *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Also, this is an apparatus claim and <u>intended use</u> limitation for the system/device or apparatus, i.e. "for discriminating ....and transmitting..." in the preamble, carries <u>no</u> patentable weight. Also, method steps, such as "which <u>communicates</u>" as shown in the preamble, or "database which <u>stores</u>..." or "a user who <u>uses</u> ...", also has no patentable weight.

Also, as for the limitation "order <u>data</u> of a new consumable....", in element (a), the term "order" and "of a new consumable ...", they are considered as non-functional descriptive material (NFDM) on the data of "inputted data", thus having no patentable weight. The mere insertion of "order" or "new item" or sources of data over "data" <u>does not</u> "impart <u>functionality</u> when <u>employed as a computer component</u>", thus having no patentable weight. They are not imparting any function on the computer to carry out any functions or functional elements or the limitation does not "impart <u>functionality</u> when <u>employed as a computer component</u>", thus having no patentable weight. The last element of the claim merely calls for providing a data, a price data, to be displayed.

See MPEP 2106.01 "Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which <u>impart functionality when employed as a computer component</u>. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

Note in the last element (h), the phrase "..to display..." is <u>not a positively recited functional element</u> but, rather, is mere <u>intended use</u> of the <u>logged information</u> and thus having no patentable weight. See MPEP 2173.05 (q), 2106, and 2111.04, which indicate that a method claim requires active, positive steps. Furthermore, it is considered as non-functional descriptive material (NFDM) on the data of "...", thus having no patentable weight. The limitation does not "impart <u>functionality</u> when <u>employed as a computer component</u>", thus having no patentable weight.

Similarly, JOHNSON ET AL fairly discloses a fully **<u>integrated sales automation system</u>** comprising a server, which communicates with a plurality of client computers through a computer network, for discriminating log-in information received from each client computer, and transmitting data of an order screen used by a user for the purpose of ordering a new consumable, to a logged-in client computer, said server comprising:

{see col. 7, lines 29-65 "...*Fig. 2.* ..*a **server-based back office system** 200*",

Figs. 1, 4, 5, 7, 12, 13, 15, 17}

a) a first input section, arranged to input order data of a new consumable

inputted by a user who uses the order screen displayed on a monitor of the logged-in

client computer;

{see Figs. 1, 13, 17, cols. 5-6}

b) a second input section, arranged to input collecting data of a used

consumable returned from the user;

{see Figs. 1, 4, cols. 5-6}

c) a database which stores the order data and the collecting data in relation

with the log-in information;

{see Figs. 1, element 116, col. 4, lines 5-47}

d) a first calculator, arranged to calculate a value data about sales or sale

transactions such as quote, finance and proposal for potential customer purchase from

a plurality of the order data and a plurality of the data stored in said database;

{see Figs. 1, 2, 4, cols. 4-5}

e) a second calculator, arranged to calculate a value data about incentives based

on a plurality of order data and other customer purchase data;

{see Figs. 10A, element 1014, Figs. 12, and 15A, 15B and 15C}

f) an exception handler, arranged to send an inquiry to the user about an event

{see Fig. 19, element 201, such as 1904, 1902, 1906 and 1908, col. 32, lines 48-

60}

g) a generator, arranged to generate price data of the new consumable in

accordance with the incentive data in the unit of the log-in information; and

{see Fig. 13, 1302, Figs. 15A-15C, col. 15, lines 15-67 "...*finance module 410 ...*

*calculate...edit... **price**, **net trade value**, ... Payment calculation engine....*", cols. 23-

24, 28-29}

h) a provider, arranged to provide the logged-in client computer with the price

data corresponding to the log-in information of that client computer to display a price of

the new consumable on the order screen, and, in response to an instruction of the user,

to provide the logged-in client computer with data of a confirmation screen to be

displayed to the user, which includes the order data, the collecting data, the collecting

rate, and the incentive data as a discount rate of a new consumable corresponding to

the log-in information of that client computer.

{see Figs. 3, "Web Site", Fig. 10A, element 1041, 1032, Fig. 12, element 1212,

1218, 1220, Fig. 13 and 15A-15C, cols. 28-29}.

Note on Figs. 15A-15C, JOHNSON ET AL discloses the general concept of

listing every data or issues, order data, incentive data, credit, net trade value data,

collecting data, etc., related to the customer transactions in details for easy monitoring if

desired. Therefore, in view of this listing teaching, the displaying or listing of any

desired data such as collecting rate, collecting data, etc., would have been obvious as

mere listing of other desired data related to the customer past and future transactions.

JOHNSON ET AL fairly teaches the claimed invention <u>except for</u> (1) the types of

data or value of data on step (b) data of a used consumable returned from a user, and

(2) step (d), a collecting rate, and using this data as a component or input in the

subsequent steps and (3) the type of exception with respect to the collecting rate

problem in the event/exception handler.

   AAPA, as shown under the "Background of the Invention", specification pages 1-

3, Figs. 1-2, discloses a collecting method of collecting used items, i.e. office supplies,

comprising the steps:

   b) collecting client's collecting data (collecting rate) of the items, used

consumable, i.e. office supplies, returned from a user, by a collecting center or the like

(dealer);

   (d) and (e) calculating the client's collecting rate and incentive data compliance

with the collecting data above wherein the calculating is carried out by collates

collecting data of the customer with a record of orders accepted (sale);

   (h) providing information about the collecting rate and incentive data on a report

to the client by conventional method, which is by mail.

   Therefore, it would have been obvious to a person having ordinary skill in the art

(herein after as "PHOSITA") at the time of the invention was made to modify the

teachings, steps (b) and (d) of JOHNSON ET AL to include other well known price

discounts such as a used consumable returned from the user in order to receive

discount for a new consumable while reducing environmental issues of dumping used

items.

The teachings of JOHNSON ET AL and AAPA teaches the claimed invention except for the type of exception with respect to the collecting rate problem in the event/exception handler.

In another system/method for efficient handling of product return transaction using the Internet, JUNGER discloses an effective system for receiving, collecting, crediting and verifying product returned in compliance with a return policy, purchase transaction, etc., to permit reduced prices to the customer and/or provide improved operating margins for the manufacturer and/or retailer while achieving 2 major savings: (1) reducing the number of improper or fraudulent returns and (2) improving efficiency and reducing overhead in handling proper returns {see cols. 1-2, and 6-7, Figs. 4A, 4B and 3}. Therefore, it would have been obvious to a person having ordinary skill in the art (herein after as "PHOSITA") at the time of the invention was made to modify the teachings, exception features in step (f) of JOHNSON ET AL /AAPA to include verifying and responding features in compliance with product return policies as taught by JUNGER in order to achieve one of the benefits cited above, i.e. to permit reduced prices to the customer and/or provide improved operating margins for the manufacturer and/or retailer while achieving 2 major savings.

Note on Figs. 15A-15C, JOHNSON ET AL discloses the general concept of listing every data or issues, order data, incentive data, credit, net trade value data, collecting data, etc., related to the customer transactions in details for easy monitoring if desired. Therefore, in view of this listing teaching, the displaying or listing of any desired data such as collecting rate, collecting data, etc., would have been obvious as

mere listing of other desired data related to the customer past and future transactions.

This general listing/displaying of all related information or data with respect to the

transaction is also taught by JUNGER on Figs. 4C and 4H.

As for dep. claims 108-109 (part of <u>94</u> above), which deal with well known data

collection parameters, kind or type of consumable and incentive/award points

determining parameters as a function of collecting state and order state, these are fairly

taught in AAPA page 3, lines 1-3 or JUNGER cols. 1-2, and 6-7, Figs. 4A, 4B and 3.

12.   **As for independent method claim <u>100</u> and computer <u>program product</u> claim**

<u>104</u>, which is the respective method and computer program product to carry out the

respective system of independent system claim <u>94</u> above, it's rejected over the

respective system and computer program product to carry out the respective system as

taught by JOHNSON ET AL /AAPA /JUNGER above. Alternatively, the setting up of a

method steps and computer program product to carry out the respective system claim of

94 above would have been obvious to a PHOSITA as mere carrying out the system

claim functions to achieve its scope.

Response to Arguments

13.   Applicant's arguments filed 12/23/08 have been fully considered but they are not persuasive in view of the new ground of rejections.

Conclusion

14.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) US Patent 6,167,382 by SPARKS et al, discloses a method for ordering, purchasing of items using the Internet with displaying of "order confirmation" {see Fig. 61} and "Order Complete" {see Fig. 62} for multiple logged-in client computers {see Figs. 1-59}. The teaching of complete "order confirmation" and "order Complete" are cited here for applicant's awareness of potential use in the future if needed to show well known teachings of step (g) in claim 100 above.

2) JP 6096094, 1994, discloses an article and device for collecting the article with merits/bonuses given to a user who cooperates with the collection system, similar to the teachings of AAPA cited above. It's cited for applicant's awareness for potential use in the future if needed to avoid citing duplicate rejections.

No claims are allowed.

15.   Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval (PAIR) system. Status information for
published applications may be obtained from either Private PAIR or Public PAIR.
Status information for unpublished applications is available through private PAIR only.
For more information about the PAIR system, see http://pair-direct@uspto.gov. Should
you have any questions on access to the private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll free).

        In receiving an Office Action, it becomes apparent that certain documents are
missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for
copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or
e-mail CustomerService3600@uspto.gov .

        Any inquiry concerning the merits of the examination of the application should be
directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule
is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off
every other Friday.

        Should I be unavailable during my normal working hours, my supervisor Janice
Mooneyham can be reached at (571) 272-6805.
        The main FAX phone numbers for formal communications concerning this
application are **(571) 273-8300**. My personal Fax is (571) 273-6806. Informal
communications may be made, following a telephone call to the examiner, by an
informal FAX number to be given.

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689
3/26/09